REMARKS

Claims 1-4, 6-13, 15-17, 19-23, 25-32, 34-36, 38-42, 44-51, 53-55 and 57 remain pending. Each of these claims stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,999,912 ("Wodarz") in view of U.S. Patent No. 5,974,455 ("Monier"), U.S. Patent No. 6,108,637 ("Blumenau") and U.S. Patent No. 6,311,211 ("Shaw"). Applicants respectfully traverse these rejections for the reasons set forth below.

I.   THE REJECTIONS OF INDEPENDENT CLAIMS 1, 20 AND 39

Independent Claim 1 recites a method of associating dynamically generated Web page content with a user who requests a Web page from a Web server that comprises:

(a)   storing a record of the user request within a Web server log;

(b)   generating the requested Web page, wherein the generated Web page includes a content object having a unique identifier associated therewith, wherein the unique identifier is generated via a hashing function;

(c)   serving the generated Web page to the Web client; and

(d)   appending the stored record of the user request with the unique identifier associated with the content object included within the generated Web page.

Independent Claims 20 and 39 contain similar recitations in the format of system and computer program product claims. The Office Action states that it would have been obvious to a person of skill in the art to combine the teachings of the Wodarz, Monier, Blumenau and Shaw references to arrive at the method of Claim 1. (Office Action at 3-5). However, as discussed below, the cited combination of references fails to teach or suggest all of the recitations set forth in Claim 1, and a person of skill in the art would not have been motivated to combine the references in the manner suggested in the Office Action. Accordingly, the rejections of Claims 1, 20 and 39, and the claims depending therefrom, should be withdrawn.

A. The Cited Combination of References Fails to Teach or Suggest All of the Recitations of Claim 1

As an initial matter, the cited references fail to teach at least the recitation of Claim 1 of "appending the stored record of the user request with the unique identifier associated with the content object." While the Office Action cites to Blumenau as disclosing this recitation, what Blumenau in fact discusses is "mak[ing] a record of requests for files" where the "files" referred to in Blumenau are "file[s] representing [a] Web page." (*See* Blumenau at Col. 2 at 21-22 and 32-34). Thus, Blumenau at most discloses making a record of the user's request for a specific web page. In contrast, Claim 1 of the present invention recites not only "storing a record of the user request" – the action discussed in Blumenau – but also recites "appending the stored record of the user request with the unique identifier associated with the content object." Contrary to the statement in the Office Action, Blumenau does not teach or suggest that information regarding a web pages references to other files are stored in the "log file." Instead, the passage cited in the Office Action makes clear that what is placed in the "log file" are the actual user requests for the "file" that represents each web page. Thus, as Blumenau at most teaches storing a record of user requests for web pages – and not the further step of appending to those stored records a unique identifier associated with at least one content object that is included within the web page, the rejection of Claim 1 should be withdrawn.

B. The Cited References Cannot Properly Be Combined to Reject Claim 1

To establish a *prima facie* case of obviousness, in addition to showing that the cited combination of prior art references teaches all the elements of the claim it must also be shown that there was some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify and combine the references in the manner suggested in the rejection. MPEP § 2143.01 *citing In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). As recently emphasized by the Court of Appeals for the Federal Circuit, the suggestion or motivation to combine the cited references in the manner suggested must be **clear**

and particular, and this requirement is not met by broad and conclusory statements about the teachings of the references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). As the Federal Circuit has explained, what is required is particular evidence as to the **reason** a skilled artisan, with no knowledge of the claimed invention, **would have selected the components of the claimed invention for combination**. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). Applicants respectfully submit that such a showing has not and cannot be made in this case.
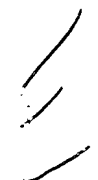
Applicants respectfully submit that the Office Action fails to provide a proper *prima facie* obviousness rejection. For instance, Office Action first states that the skilled artisan would have been motivated to modify the Wodarz reference to use the hash function discussed in Monier "to provide a unique identifier for each advertisement . . . since the hash function was well known for providing a unique identifier of a piece of data." (Office Action at 3). However, as the Monier reference itself makes clear, hash functions are useful for generating unique identifiers in situations where there are extremely large numbers of items requiring unique identifiers; for instance, Monier discusses using a hash function to generate 2^{63} distinct identifiers. (Monier at Col. 5, lines 62-64). The Wodarz reference is directed to a method for rotating the advertisements that are displayed on a web page. Wodarz thus deals with a situation where there is a relatively small number of items which are stored in a database for insertion into the web page, a fact that is confirmed by the example set forth in Table 1 of Wodarz which lists four advertisements. Using a hashing function to generate identifiers for small sets of items is not only unnecessary; it also would be an inefficient use of resources and is exactly the type of modification to Wodarz that a person of skill in the art would be motivated **not** to do. As such, it is clear that a skilled artisan would not have been motivated to combine the Wodarz and Monier references in the manner suggested in the pending rejection of Claim 1 and, as such, the rejection should be withdrawn.

Applicants likewise submit that there has been no showing that a skilled artisan would have been motivated to combine the Wodarz and Blumenau references in the manner suggested in the rejection of Claim 1. Specifically, Wodarz is directed

to a method for cycling advertisements so that more advertisements may be displayed on a particular web page. While Wodarz does indicate that the advertisements that are to be displayed may be chosen "based upon user-specific characteristics", the types of "user characteristics" Wodarz is discussing are **physical characteristics** of the user "such as age, sex, language, etc." (Wodarz at Col. 3, lines 65-67). Wodarz contains no suggestion whatsoever that the advertisements would be selected based on "monitoring information" that has been collected "from which conclusions may be deduced **regarding the observation of the displayed content by an observer**" – *i.e.*, the type of information discussed in the Blumenau reference. (*See* Blumenau at Abstract). As such, there is simply no reason that a person of skill in the art would have been motivated to combine the Wodarz and Blumenau references in the manner suggested, as Wodarz teaches that the selection of the advertisements that are to be displayed should be based on (1) least recently viewed algorithms, (2) random selection, (3) time of day, (4) physical characteristics of the user, or (5) the number of times that the advertisement has previously been displayed within a given time period as opposed to an analysis of the web page content that a user has chosen to previously view. Accordingly, the rejection of Claim 1 should be withdrawn for this additional reason.

C. Claims 2-4, 6-8, 20-23, 25-27, 39-42 and 43-46 are Patentable for Similar Reasons

As noted above, independent Claims 20 and 39 comprise a counterpart system claim and a counterpart computer program product claim to Claim 1, and these claims are rejected based on the exact same reasoning as was used to reject Claim 1. As such, the reasoning discussed above with respect to the deficiencies in the rejection of Claim 1 apply equally to Claims 20 and 39, and the rejections of Claims 20 and 39 should likewise be withdrawn. Additionally, Claims 2-4, 6-8, 21-23, 25-27, 40-42 and 43-46 each depend from independent Claim 1, 20 or 39, and thus the rejections of these claims should be withdrawn for at least the reasons discussed above with respect to Claims 1, 20 and 39.

II. THE REJECTIONS OF INDEPENDENT CLAIMS 9, 13, 28, 31, 47 AND 51

The Office Action rejects independent Claims 9, 13, 28, 31, 47 and 51 based on a similar rationale to the rationale stated for the rejection of Claim 1. In particular, the Office Action relies on identical reasoning in the rejection, and further states that the additional recitations in Claims 9, 28 and 47 regarding the web page including first and second content objects and the additional recitation in Claims 13, 31 and 51 regarding associating dynamically generated web page content with a user who requests a web page from a web server via a web client in communication with the web server are taught by the Wodarz reference. However, as discussed above with respect to independent Claim 1, the cited art fails to teach at least the "appending the stored record of the user request" recitation, and the rejections improperly combine references that a skilled artisan would not have been motivated to combine. Accordingly, independent Claims 9, 13, 28, 31, 47 and 51, and the claims (Claims 10-12, 15-17, 19, 29-31, 34-36, 38, 48-50, 53-55 and 57) that depend from them are patentable over the cited art for the reasons set forth with respect to Claim 1.

CONCLUSION

Applicants submit that the present application is in condition for allowance and the same is earnestly solicited. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,

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In re: Nguyen et al.
Serial No.: 09/207,945
Filed: December 9, 1998
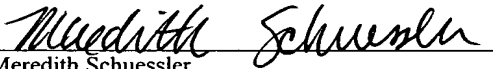Page 20

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